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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,472	10/30/2001	Ellen M. Meyer	BDD.10171	1672
8933	7590	09/07/2006		
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			EXAMINER CHORBAJI, MONZER R	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,472

Applicant(s)

MEYER, ELLEN M.

Examiner

MONZER R. CHORBAJI

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,13,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,7,13,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This final action is in response to the RCE/Amendment received on 08/21/2006

Claim Rejections - 35 USC. § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 6-7, 13 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (WO 99/46350).

Regarding claims 1 and 13, Lin discloses a method for deodorizing an aqueous solution (page 1, numbered lines 6-10, page 10, numbered lines 25-30 and example 1) that includes an odoriferous compound (page 1, numbered line 9). Lin teaches adding an amount of 5-Chloro-2-methyl-4-isothiazolin-3-one as the organic halogen donor (page 10, table 4) that chemically reacts with the odoriferous compound thereby deodorizing the aqueous system.

Regarding claims 6-7 and 18-19, Lin teaches in table 4 of page 10 adding 0.024 percent by weight of a combination of 5-Chloro-2-methyl-4-isothiazolin-3-one and 2-methyl-4-isothiazolin-3-one. For example, Conversion of 300 ppm to %w: $(300 \text{ ppm}) / (10,000 \text{ ppm} / \%) = 0.03 \% \text{ w}$. Thus, 0.024 % w of 5-Chloro-2-methyl-4-isothiazolin-3-one and 2-methyl-4-isothiazolin-3-one represents 240 ppm together. For example, if 0.001 % w of 5-Chloro-2-methyl-4-isothiazolin-3-one is combined with 0.023 % w of 2-methyl-4-isothiazolin-3-one totaling 0.024 % w, then 0.001 % w of 5-Chloro-2-

methyl-4-isothiazolin-3-one represents 10 ppm, which falls within the recited ranges in claims 6-7 and 18-19.

Response to Arguments

3. Applicant's arguments filed on 08/21/2006 have been fully considered but they are not persuasive.

On page 4 of the Remarks section, applicant argues that, "In contrast, the present invention does not teach or contemplate the use of microbial growth enhancers, as reflected in the instant claims as amended." The examiner disagrees since the scope of the instant claims does not preclude the use of such enhancers and the examiner cannot import limitations from the disclosure into the instant claims. The presence of lack of such enhancers is irrelevant with respect to the scope of the instant claims.

On page 4 of the Remarks section, applicant argues that, "Indeed, in accordance with the present invention, the addition of additional microbial sources would be potentially deleterious to the particular systems such as paper mills, municipal waste treatment plants to be treated." The instant claims do not recite the above listed examples of systems, nor the disclosure teaches that the combination of microbial sources is deleterious to such systems. In addition, the totality of the disclosure does not teach the explicit exclusion of other components that would materially affect the basic and novel characteristics of the claimed method. See MPEP 2111.03.

On bottom page 4 to top of page 5 of the Remarks section, applicant argues that, "In contrast, Applicant specifically discloses and claims a chemical method for deodorizing, and expressly states the disadvantages of using chemical neutralizers in

the specification at page 2, lines 17-27. " In evaluating lines 17-27 on page 2 of the specification, Applicants give their subjective suggestions that under certain conditions where disadvantages of using neutralizing agents might possibly occur. These are hypothetical situations and not teaching against including such agents. Clearly, including chemical neutralizers and microbial components in combination with 5-Chloro-2-methyl-4-isothiazolin-3-one would not alter Applicant's claimed invention.

Conclusion

4. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1744

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R. CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 9:00-5:30.
7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GLADYS J. CORCORAN can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRC 


GLADYS JP CORCORAN
SUPERVISORY PATENT EXAMINER